

**REMARKS**

Claims 1-12, 14-15 and 18-27 are pending in the current application and currently stand rejected. Claims 1, 20, 21, 22, and 23 have been amended. Applicant respectfully traverses.

**I. Claim Rejection under 35 U.S.C. 103**

Claims 1-5, 14-15, 18-20 and 25 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent 1,121,197 to McMillan (hereinafter McMillan) in view of U.S. Patent No. 6,209,917 to Welch (hereinafter Welch). Applicant respectfully traverses.

The Examiner asserts that the McMillan reference discloses a binder arrangement comprising a pair of covers each cover being composed of covers and back respectively each hingably carried a predetermined distance from a centerline of a spine each of the pair of covers being constructed with a pivoting surface that pivots 90 degrees against each of the hinges and wherein the centerline is located at the midpoint between a first and second side edge, a first set of binders permanently fixed at a location adjacent to and parallel to the hinge and carried by one of the covers and a second set of binders including a plurality of binding mechanisms, the binders being carried by the other one of the covers wherein both of the first set of binders and the second set of binders are located closer to the centerline than to either of the first or second side edges and fixed substantially hermaphroditical with respect to each other and wherein the sets of binders are offset from one another such that one set of binders is spaced farther away from the centerline of the spine than the other set of binders and the sets of binders do not overlies each other when the binder arrangement is disposed in a closed position with one of the covers generally overlying the other one of the covers. The Examiner states that McMillan fails to

Page 10

disclose the covers and spines being defined by a board having hinges comprised of scores and asserts that Welch cures the deficiencies of McMillan.

Applicant responds that amended independent Claims 1, 20, 21, 22 and 23 now include the limitation pivotable about a single axis into an opposed orientation. McMillan does not teach or suggest such an arrangement and in fact specifically teaches away from such an arrangement. McMillan discloses having covers 1 and 2 pivotable about two separate axes 3 and 4. (See Figures 1-3 and Column 1, Lines 32-34). One skilled in the art would not look to McMillan to learn how to construct a binder, as in the present invention, with covers closing about a single axis and offset binders because McMillan discloses having binders close about two separate axes. In fact, McMillan specifically discloses having "two oppositely disposed packets or series of sheets or leaves within the same covers..." Col 1, Lines 39-41 which close about opposed hinges in order to provide "a book which while having double the capacity of the usual loose-leaf book will, nevertheless, have but little, if any, greater or appreciably greater thickness..." Col 1, Lines 25-29. **The invention of McMillan can not work with binder covers that pivot about a single axis.** Therefore McMillan alone or in combination with Welch does not contain any motivation to teach or suggest the present invention as claimed in amended claims 1, 20, 21, 22 and 23.

As stated above McMillan does not disclose having binders covers pivotable about a single axis into an opposed orientation as in the amended claims and as such McMillan cannot teach or suggest the current invention in accordance with the amended independent claims 1 and 20-23. Welch fails to cure the deficiencies of McMillan.

Specifically, Welch discloses:

**In FIG. 2 there is illustrated the novel unibody binder construction 40 in which the primary component consisting of a single piece of board 41 of uniform thickness that is formed into front and back covers 42, 43 by a hinge construction 44**

Page 11

consisting of a series of longitudinally extending creases 45 that are pressed into the board 41 and formed into a rounded spine section 46. A three ring mechanism 50 is secured by rivets (not shown) to the back cover 43. There is no reduction in the thickness of board 41 in any section thereof. Column 5, lines 23-33

And again at Column 6, lines 6-14

**“By maintaining this uniform thickness the spine portion of the binder formed by the living hinges are over 500% stronger than that of the prior art arrangements disclosed and illustrated in FIGS. 1A-D. The hinges are formed by longitudinally extending creases 45 that are pressed into an intermediate section of the board throughout its length by a series of steps to be hereinafter described. The creases are formed by displacing material and not removing material.”**

Thus Welch explicitly states that the unibody binder hinges are formed of longitudinal creases that cause **NO REDUCTION IN THE THICKNESS OF BOARD 41 IN ANY SECTION THEREOF**. This requirement is reinforced later in the Specification of Welch where it is stated that **“By maintaining this uniform thickness the spine portion of the binder formed by the living hinges are over 500% stronger than that of the prior art arrangements disclosed.”** Welch clearly illustrates this requirement in Figs 8-11, where it is shown that each of the creases used to form the living hinge results in a corresponding bulge on the opposite surface of the board resulting in no change to the thickness of the board. In contrast to Welch, the present invention as set forth in amended independent claims 1 and 20-23 includes the limitation that said pair of covers and spine are defined by a board that includes a pair of spaced apart integrally formed hinges with each hinge being comprised of a plurality of pairs of scores formed in an interior surface of said board, wherein each score comprises a slit formed in the interior surface of said board that does not extend completely through said board, and wherein said scores of each hinge define a region of said board that is compressed to a thickness that is less than the surrounding thickness of said board;...

Therefore neither McMillan nor Welch alone or in combination teach or suggest the current invention in accordance with the amended independent claims 1 and 20-23. Thus claims 1 and 20-23 and the claims dependent thereon are patentable over the cited references. Reconsideration is respectfully requested.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) In the present case even if Welch were to disclose the hinges of the present invention, which it does not, there is no such suggestion present, as the prior art does not suggest the desirability of the combination of flexible hinges formed with slits to pivot covers about a single axis because McMillan discloses having binders close about two separate axes.

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000)

"Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." Dembiczak, 175 F.3d at 999; see also Ruiz, 234 F.3d at 665 (explaining that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions). This is because "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to

Page 13

defeat patentability—the essence of hindsight.” Dembiczak, 175 F.3d at 999.

Therefore, we have consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”); *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”). *Teleflex v. KSR International*, 04-1152 (CAFC 2005).

Thus amended independent claims 1, and 20-23 and the claims dependent thereon are patentable over the cited references. Reconsideration is respectfully requested.

Claims 6-9 and 21 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over McMillan in view of Welch and further in view of Zimbelman. Applicant respectfully traverses. Applicant notes that the Examiner in his Official Action on page 5 and 6 cites a reference “Podosek”, without any further identifying information or specific citation to any limitations for a rejection. Applicant therefore has treated the reference to “Podosek” as a typographical error and assumed Welch was the proper reference.

As stated above the combination of McMillan and Welch does not disclose a binder arrangement comprising: a) a pair of covers, pivotable about a single axis into an opposed orientation and a hinge comprising a plurality of scores slits formed in the interior surface of the board with the binders mounted closer to the centerline than the side edges as in the amended claims and as such the combination of McMillan and Welch cannot teach or suggest the current invention in accordance with the amended independent claims 1 and 20-23. Zimbelman fails to cure the deficiencies of the

Page 14

combination of McMillan and Welch and therefore neither the combination of McMillan and Welch nor Zimbelman alone or in combination, teach or suggest the current invention in accordance with the amended independent claims 1 and 20-23. Thus claims 1 and 20-23 and the claims dependent thereon are patentable over the cited references. Reconsideration is respectfully requested.

Claims 10-12 and 22 and 24 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over the combination of McMillan and Welch in view of Moor. Applicant respectfully traverses. As stated above the combination of McMillan and Welch does not does not disclose a binder arrangement comprising: a) a pair of covers, pivotable about a single axis into an opposed orientation and a hinge comprising a plurality of scores slits formed in the interior surface of the board with the binders mounted closer to the centerline than the side edges as in the amended claims and as such the combination of McMillan and Welch cannot teach or suggest the current invention in accordance with the amended independent claims 1 and 20-23. Moor fails to cure the deficiencies of the combination of McMillan and Welch and therefore neither the combination of McMillan and Welch nor Moor alone or in combination teach or suggest the current invention in accordance with the amended independent claims 1 and 20-23. Thus claims 1 and 20-23 and the claims dependent thereon are patentable over the cited references. Reconsideration is respectfully requested.

Claims 26-27 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over above the combination of McMillan and Welch and further in view of U.S. Patent No. 5,332,327 to Gillum (hereinafter Gillum) Applicant respectfully traverses.

As stated above As stated above the combination of McMillan and Welch does not does not disclose a binder arrangement comprising: a) a pair of covers, pivotable about a single axis into an opposed orientation and a hinge comprising a plurality of scores slits formed in the interior surface of the board with the binders mounted closer to the centerline than the side edges as in the amended claims and as such the combination

Page 15


of McMillan and Welch cannot teach or suggest the current invention in accordance with the amended independent claims 1 and 20-23.. Gillum fails to cure the deficiencies of the combination of McMillan and Welch and therefore neither the combination of McMillan and Welch, or Gillum alone or in combination do not teach or suggest the current invention in accordance with the amended independent claims 1 and 20-23. Thus claims 1 and 20-23 and the claims dependent thereon are patentable over the cited references. Reconsideration is respectfully requested.

As the prior art references fail to disclose, teach or suggest the combination of features as claimed, Applicant respectfully requests that the Examiner reconsider the rejections in view of the remarks above. Applicant respectfully solicits allowance of this application.

It is Applicant's position that all claims are now allowable. Should the Examiner determine that issues remain that have not be resolved by this response, the Examiner is requested to contact Applicant's representative at the number listed below.

Favorable consideration is requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Stephen Cannavale", is written over a horizontal line.

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